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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,742	01/23/2004	David J. Dodge	08511-01CT1	7668
21918	7590	08/12/2004	EXAMINER	
DOWNS RACHLIN MARTIN PLLC			PATTERSON, MARIE D	
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DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,742	<b>Applicant(s)</b> DODGE, DAVID J.	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.  
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 32-35 and 42-64 is/are pending in the application.  
 4a) Of the above claim(s) 51,55 and 61-63 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 32-35, 42-50, 52-54, 56-60 and 64 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1/23/04.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Claims 51, 55, and 61-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention and/or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9 of application 09/966257. Note that this is a continuing application and therefore MPEP 819 states that the restriction election in the parent application carries over to the child application when the child applicant is a continuing application and not a divisional or continuation in part.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 52, 54, and 56-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Bejean (5954358).

In reference to claims 56-60, Bejean shows a binding comprising a base (13), a latch (15) with a pivot axis (153), a catch (151) which is attached to said latch and which is spaced from said pivot axis and is capable of removing coherent material from a cavity

(formed between elements 11 and either 122 and 123 or the sole of the shoe), and an opening through said latch (formed below the pivot axis (153) and above the base and extending over laterally to element 151) as claimed.

In reference to claim 52, Bejean shows a binding comprising a base (13) and first means (15) which releasably engages an engagement member (11) and the first means is "self clamping" (i.e. the user merely needs to step onto the binding which the pressure of element 11 would cause element 158 to rotate to allow it to pass below element 158 and element 158 would return to the original orientation (due to the pressure of the springs 157a and b) blocking the upward motion of the element 11, therefore the first means self clamps or "automatically fits" as stated by Bejean the shoe to the binding) as claimed.

3. Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Bayer (5957479).

Bayer shows a binding comprising a base (1016 or 16) with a first means (1020 or 20) engaging said base for releasably engaging the engagement member and the first means being self clamping (as shown in figures 6A-6C) as claimed.

4. Claims 52, 54, and 56-59 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Morrow (6189913).

In reference to claim 56, Morrow shows a binding comprising a base (52), a first means (78) for releasably engaging the receiver, second means for ejecting the coherent material (the rounded element 80 and the lower point shown in figure 10), and

a third means for allowing the coherent material to move away from the receiver (the space between element 46 and 52, shown in figure 10) as claimed.

5. Claims 52, 54 and 56-58 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Karol (5690351).

In reference to claims 52 and 54, Karol shows a "self clamping" binding, i.e. it clamps and hold the engagement member in position as claimed.

In reference to claims 56-58, Karol shows a binding comprising a base 36), a first means (34 and 44), a second means (curved top shape of element 34), and a third means (angled portion shown at 40 in figures 7 and 9) as claimed.

6. Claim 32 is rejected under 35 U.S.C. 102(a or e) as being anticipated by Warner (5901471).

Warner shows a binding comprising a toe member (54), a heel member (34), a first means and second means (elements 46 located on the medial and lateral sides of the binding which are clearly capable of being received into receivers located on the medial and lateral sides of an engagement member at 44 of a footwear 10 having such elements), and a third means (shown in figure 3 as a bar with holes and an adjustment screw/pin) for adjusting the distance between the toe and heel members as claimed. It is noted that claim 32 does not positively recite or claim the footwear or the engagement member as part of the combination, such elements have been merely recited as part of an intended use recitation and have been treated as such.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warner (5901471) in view of Polk (5794362).

Warner shows a binding comprising a binding as discussed above substantially as claimed except for the exact third means. Polk teaches the use of a threaded rod (160) for adjusting the distance between a toe (42) and heel member (40). It would have been obvious to use a threaded rod as taught by Polk as the third means for adjusting the distance between the heel and toe members in the binding of Warner to provide increased options of adjustability and to make the adjustment quicker and easier.

9. Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson (5970632) in view of Bejean (5954358).

Watson shows a binding comprising a toe member (310 and 311), a heel member (312), first means for releasable engagement (311) with a boot, and a second means for adjusting the distance between the heel and toe members (315 and threaded rod 318) substantially as claimed except for the exact first means for releasable engagement with the boot. Bejean teaches the use of latches with catches and springs (as discussed above) as means for releasably engaging boots. Watson clearly

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suggests looking to snowboard bindings for suggestions to modify (see figure 18 and column 10 lines 26-49). It would have been obvious to use latches with springs and catches as taught by Bejean in the binding of Watson to provide a binding which is easier and quicker to attach and detach.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 32-35, 42-55, and 64 rejected under the judicially created doctrine of double patenting over claims 1-31, 41, and/or 42 of U. S. Patent No. 6,684,534 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: all claims are directed towards bindings with self-clamping latches on rotational axis for use with an engagement member with receivers as specified in the claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

***Allowable Subject Matter***

10. Claims 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and subject to the filing of a terminal disclaimer.
4. Claims 42-47 are allowed subject to the filing of a terminal disclaimer.

***Response to Arguments***

5. Applicant's arguments filed 1/23/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the rejection of claims 52-55 based on the definition of "self-clamping", it is noted that the term clamping is defined in Webster's New World Dictionary as "gripping, fastening, or bracing" and Claims in a pending application should be given their broadest reasonable interpretation. In *re* Pearson, 181 USPQ 641 (CCPA 1974). The devices of the prior art are considered to be "self-clamping" inasmuch as such has been defined in the claims because they grip and fasten the engagement member to the binding.

In reference to applicants' arguments directed towards Karol, the elements 60 are clearly a cavity and applicants arguments that they are not cavities are not understood,



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especially since these structures appear to be the same as those disclosed by applicant as cavities. Also, it is noted that the cavities are recited as merely a part of an element which is part of an intended use recitation and cavities have not been positively claimed and recited as part of a combination.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

  
Marie Patterson  
Primary Examiner  
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